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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,599	10/16/2001	Rony A. Abovitz	ZKT 2 0014	5128
7590	12/30/2005			
Thomas E. Kocovsky, Jr. FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP Seventh Floor 1100 Superior Avenue Cleveland, OH 44114-2518			EXAMINER JUNG, WILLIAM C	
			ART UNIT	PAPER NUMBER
			3737	
DATE MAILED: 12/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Tenth

Office Action Summary

Application No.

09/978,599

Applicant(s)

ABOVITZ ET AL.

Examiner

William Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15, 17-32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-15, 17-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed October 13, 2005 have been fully considered but they are not persuasive.

After further consideration, examiner respectfully disagrees with the applicant's response. In regards to claims 2-4, the disposable kit as "openable and transportable case." However, disposable kit in software would be defined as any software that can be removed from the operating system, whether it is removed from user control or automatic control shutdown of the software. Since the claims do not define the specific disposing of the software, the prior art of record anticipate and/or obviate the claimed invention. Claims 7-15, 17-32, and 34-39 are based on similar argument on claims 2-4 above. Therefore, previous rejection is maintained and repeated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-15, 17-32, and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kienzle, III et al* (US 6,285,902 B1) as applied to claim above, and further in view of *Martinez* (US 4,577,629) and *Lichtenstein* (US 4,370,983).

Kienzle, III et al substantially disclose all claimed features in claims 2-15, 17-32, and 34-39.

Claims 2, 5, 7-11, 20, 23, 30, 31, 38, and 39: Kienzle, III et al disclose a method and apparatus where an imaging guided surgery system with computer includes an image guided surgery software that provides an minimal user functionality by having specific software enabled to apply preselected surgical procedure and software-integrated kit for instrumented tools and digital medium with image guided surgery software to facilitate the performance of the surgical procedure and a tracking system to locate the surgical tools via display used in conjunction with the computer (col. 4, line 16 – col. 5, line 13; col. 6, lines 25-35; col. 8, line 14 – col. 9, line 44). However, Kienzle, III et al do not disclose that the surgical tools are disposable kit. It is well known in the art that the surgical tools or instruments are disposable for safety reason where the tools are discarded to disposed until the tools are sterilized as shown by Martinez for example. In addition, Kienzle, III nor Martinez discloses that the software is disposable. However, this feature in particular is depending on application of the surgical or medical procedure and the functionality of disposing software is well known in the art as demonstrated by Lichtenstein (col. 32, lines 27-52). Although, Lichtenstein's invention is directed toward infusion of physiological fluid, the disposing of software application for microcomputer control device is well disclosed. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply the teachings of Martinez's disposable surgical tools and Lichtenstein's disposable software kit to the method and system of Kienzle, III et al described above.

Claims 3, 4, 6, 12-15, 17-19, 21, 23, 24-29, 32, and 34-37: Kienzle, III et al disclose a mobile cart 125 that holds computer 121, 124 and display 122 which receive and display digital data obtained from the imaging unit 112 as shown in figure 1. In addition, the image-guided

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system includes position-monitoring sensor 123 tracking the position and movement of the surgical tools. Furthermore, Kienzle, III et al disclose image mapping of the where image guidance is referenced from the image coordinate correlated to position sensor and tracking device (col. 11, line 31 – col. 12, line 20).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJS

December 20, 2005

Eleni Mantis-Mercader
ELENI MANTIS-MERCADER
PRIMARY EXAMINER